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*John*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/378,233 08/19/99 PALMER

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021917 IM22/0515  
MCHALE & SLAVIN  
4440 PGA BLVD  
SUITE 402  
PALM BEACH GARDENS FL 33410

EXAMINER

DAUERMAN, S

ART UNIT

PAPER NUMBER

1761  
DATE MAILED:

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05/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/378,233**

Applicant

**Palmer et al.**

Examiner

**Sherry Dauerman**

Group Art Unit

**1761**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application

Of the above, claim(s) 3-8 and 10-20 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 2, and 9 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. This application contains claims directed to the following patentably distinct species drawn to a candy-toy combination wherein the distinct species electronic components are combined with a food stuff holding device:

- I. Claims 1, 2 and 9, drawn to species I, wherein electrical conductance controls the sound output from the device
- II. Claim 1, 3 and 8, drawn to species II, wherein voltage-controlled oscillator controls sound output from the device
- III. Claims 1, 4 and 5, drawn to species III, wherein the output means includes a speaker, a storage member and a means for sound playback
- IV. Claims 1, 6 and 7, drawn to species IV, wherein the output means includes a microphone which detects sounds and a means to broadcast the detected sounds
- V. Claims 1 and 10-13, drawn to species V, wherein electrical capacitance of a circuit assembly controls the sound output from the device
- VI. Claims 1 and 14-17, drawn to species VI, wherein electrical conductance of a circuit assembly controls the sound output from the device
- VII. Claims 1 and 18-20, drawn to species VII, wherein optical conductance controls the sound output from the device

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic to all seven species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Michael A. Slavin, Esq. on February 24, 2000 a provisional election was made with traverse to prosecute the invention of species I, generic claim 1 and distinct claims 2 and 9. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 3-8 and 10-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Priority***

4. If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

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*Specification*

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The disclosure is objected to because of the following informalities: Table I should be located within the section of the specification's Detailed Description in order to conform with the customary arrangement of a patent application.

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a candy holding device which produces sound, does not reasonably provide

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enablement for a sound which produces a shocking sensation and how the shocking sensation results in altering the tastes of a foodstuff. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. For the purposes of examination, claim 9 has been interpreted to be a foodstuff and foodstuff holding device which produces a sound and can additionally provide an "electrical sensation" to the user's tongue (page 26, paragraph 2, specification).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

10. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Rudell et al. (Pat. 5,939,983). Rudell et al. (Pat. 5,939,983) teaches a foodstuff holding device that produces sound based upon interaction with said holding device comprising (col. 3, lines 22-25 and 46-48) : a rigid housing assembly having a means for holding foodstuff (Figs. 3, 6, 14, and 20), a foodstuff member removably secured to said rigid housing (Fig. 1), output means for producing sound (Fig.

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2), said output means being supported by said housing assembly (col. 5, lines 47-56), a power supply for energizing said output means (44)(Fig. 2), said power supply being electrically coupled to said output means (42)(Fig. 2), and a control means for regulating said sound of said output means (col. 3, lines 25-29), said control means operatively joining said foodstuff with said output means (col. 5, lines 22-27), whereby said sound of said output means is governed by physical characteristics of said foodstuff wherein changes in said physical characteristics of said foodstuff produce corresponding changes in sound (col. 5, lines 52-55), wherein said foodstuff is electrically conductive (col. 6, 49-53) wherein said control means includes a first electrically conductive member associated with the housing and a second electrically conductive member associated with the foodstuff (col. 6, lines 49-53), and wherein the first and second electrically conductive members adapted to be electrically connected by body portions of an individual physically in connection with both members (col. 6, lines 49-53) for the purpose of providing added interactive amusement for the end user throughout the consumption process.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell et al. (Pat. 5,939,983) as applied to claims 1-2 above, and further in view of Matsuyama (Pat. 4,832,652). Rudell et al. (Pat. 5,939,983) as applied to claims 1-2 above fails to teach a device which produces a shocking sensation effective to alter a taste of said foodstuff.

Matsuyama teaches that is known to one of ordinary skill in the art to produce devices associated with confectionary articles (col. 1, lines 19-21) which serve as amusement devices which produce a shocking sensation after coming into physical contact with an end user (col. 1, lines 13-18) for the purposes of delivering an amusing shock to the contacted user.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the foodstuff holding device of Rudell et al. (Pat. 5,939,983) such that it produces a shocking sensation which alters the taste of a foodstuff as per the teachings of Matsuyama in order to manufacture a foodstuff holder in combination with a foodstuff which provides interactive amusement throughout the consumption process.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Pat. 3,966,972, 6/1976, Theimer et al.	- discloses using electrical food conductance
US Pat. 4,914,748, 4/1990, Schlotter, IV et al.	- discloses candy holder combined with light
US Pat. 5,464,092, 11/1995, Seeley	- discloses sound device on food container
US Pat. 5,902,167, 5/1999, Filo et al.	- discloses food holder w/ sound out put

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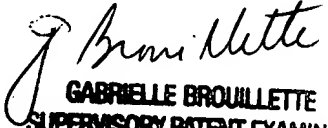
US Pat.	6,054,156, 4/2000, Rudell et al.	- discloses electr. connected food and holder
US Des.	260,655, 9/1981, Guay	- discloses musical spoon
PCT	WO 94/17691, 8/1994, Kline et al.	- discloses toothbrush combined with sound

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherry Dauerman at telephone number (703) 305-0883. The examiner can normally be reached on Monday - Friday from 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached on (703) 308-0756. The fax phone numbers for the organization where this application is assigned are (703) 305-3599 and (703) 305-7718.

Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

**Sherry A. Dauerman**  
**Patent Examiner**  
**Art Unit 1761**  
May 8, 2000

  
**GABRIELLE BROUILLETTE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1700**  
5/8/00